

**IN THE DRAWINGS**

Please cancel the one sheet of formal drawings filed with the Supplemental Response to the Official Action dated November 13, 1991, and substitute the one sheet of formal drawings submitted herewith.

**R E M A R K S**

This response to the Official Action dated July 18, 1991 is made pursuant to 37 CFR 1.116 and M.P.E.P. §714.12. The amendments set forth in this Response comply with the objections or requirements as to form. Furthermore, it is believed that the amendments set forth in this Response will place the case in condition for allowance or, at least, in better form for appeal.

The Examiner has raised certain issues in the July 18, 1991 Official Action with respect to the present application. These issues will each be addressed below.

**1. The Benefit of Continuity**

It is the Examiner's position that this application is not entitled to the benefit of priority under 35 U.S.C. §120 of the parent case, 06/648,032. Under 35 USC 120, an applicant is entitled to claim the benefit of the filing date of an earlier application for a later-claimed invention when that earlier application discloses that invention in the manner required by 35 USC 112, first paragraph. KangaROOS U.S.A., Inc. v. Caldor, Inc., 228 USPQ 32, 33-34 (CAFC 1985). It is also clear that a claim for priority under 35 USC 120 may be made in a design application based upon an earlier filed utility application.

Racing Strollers, Inc. v. TRI Industries, 11 USPQ 2d 1300 (CAFC 1989). The Federal Circuit in Racing Strollers, 11 USPQ 2d at 1301 stated:

As a practical matter, meeting the remaining requirements of §112 [those other than best mode] is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein by the prescribed formal claim . . ."

(Emphasis added).

In determining whether the drawings of a design application are properly supported by the parent application, the case of Ex Parte Asano, 201 USPQ 315 (Bd.App. 1978) is instructive. In this case, the examiner rejected the design claim citing nineteen areas of drawing problems. In reversing the decision of the examiner, the Board stated in Asano, 201 USPQ at 317:

"While we agree with the general premise, as stated by the examiner that, in design applications, the drawing or drawings constitute substantially the entire disclosure of the application and must therefore be well executed both in clarity of showing and completeness to provide an enabling disclosure and definiteness of the

claimed subject matter (see 1503.02 MPEP), neither the statute (35 USC 112) nor the regulation (37 CFR 1.152) requires blueprint type drawings of an exact scale.

Mechanical drawing errors and inconsistencies between the figures of the drawings, which do not preclude the overall understanding of the drawing as a whole are an insufficient basis for holding the design both indefinite and insufficiently disclosed under 35 USC 112. .

. . we consider the numerous mechanical drawings errors and figure inconsistencies noted by the examiner to be insignificant, and that they would present no problems as far as making the disclosed design to one of ordinary skill in the art."

See also Hadco Products, Inc. v. Lighting Corp. of America, Inc., 165 USPQ 496 (DC E.Pa., 1970), reversed on other grounds, 174 USPQ 358, cert. den. 175 USPQ 678, relied on by the Board in Ex Parte Asano, supra.

The precision of conformity required by the Examiner in this case between the drawings of the present design application and the original drawings of the patent application, is one of blueprint type exactness. Such exactness is clearly not required. Ex Parte Asano, supra. However, even by this standard it is submitted that, with regard to the shape of the head of the flashlight, adequate conformity exists between the present formal

drawings submitted in this case and the original 06/648,032 drawings. See the accompanying declarations of Fred McAlister and Robert C. Weiss attesting to the precision of conformity between the new formal drawings and the original 06/648,032 drawings and the accompanying declarations of Fred McAlister and Anthony Maglica regarding the drafting mistake concerning Figure 1 of the original 06/648,032 drawings. Thus, it is submitted that these new formal drawings overcome the Examiner's previous objections regarding the drawings and the present application is entitled to the benefit of continuity extending back to the original parent application, Serial No. 06/648,032, filed September 6, 1984.

2. The New Matter Rejection

In addition to the above objection regarding the second set of formal drawings, the Examiner has also rejected the claim under 35 USC 112, first paragraph, because of certain differences between the original drawings and this second set of formal drawings. The Examiner contends that these differences constitute new matter.

Applicant submits that these differences, to the extent that they exist, are so slight that they are inconsequential. As set forth in the MPEP §1504:

"In general terms, if the additional or amended illustration is reasonably supported by the original disclosure under 35 USC 112,

first and second paragraphs, it will not be refused entry." (Emphasis added).

Furthermore, correction of minor drafting errors or inconsistencies in the drawings will not constitute new matter. As stated in Ex Parte Asano, supra, 201 USPQ at 318:

"The errors, as we see them, are minor drafting errors or Figure inconsistencies, and it is not new matter to correct minor drafting errors or to make one figure of the drawing consistent with other figures. The test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed, but whether there is support anywhere in the drawings for the necessary or desireable figure corrections.

See also Ex Parte Kosugi, 144 USPQ 136 (Bd. App. 1964) cited by the Board in Ex Parte Asano, supra.

The differences described by the Examiner relate to (1) the candle end of the flashlight showing a partially uncovered light which the Examiner contends should be covered, (2) a threaded end which the Examiner contends is proportionally wider and taller with a smaller flat top disc, and (3) an edge on the flashlight head which the Examiner contends is too thin. It is not felt that these differences constitute new matter for the reasons

described above. However, the new formal drawings have been modified to overcome each of the problems raised by the Examiner with respect to the previous formal drawings. Thus, it is submitted that the new matter rejection has now been overcome.

3. Figure Descriptions

As indicated above, the figure description for Figure 1 has been amended in accordance with the requirements of the Examiner.

4. Claim Form

As indicated above, the form of the claim has been amended in accordance with the requirements of the Examiner.

5. The Prior Art Rejection

The Examiner finally rejected the claim under 35 USC §103 as being unpatentable over Maglica, U.S. Patent No. 4,658,336, in view of Huang, U.S. Patent No. 4,750,095. For the reasons set forth above, the present application is entitled to a benefit of continuity extending back to the original parent application, Serial No. 06/648,032, which was filed September 6, 1984. The benefit of continuity overcomes the rejection of the claim under 35 USC §103 based on two subsequently filed patents.

In view of the above, it is respectfully submitted that the application is now in condition for allowance. The Examiner is respectfully requested to promptly pass this application to

issue, particularly since a petition to make this case special on the basis on infringement has been granted.

Respectfully submitted,

LYON & LYON

Dated: December 13, 1991

By: 

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